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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,766	07/10/2000	James L. Hepworth	23802-250800	8887

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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 04/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

# Office Action Summary

Application No.

09/612,766

Applicant(s)

HEPWORTH ET AL.

Examiner

Anh Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Request for Continued Examination***

1. The request filed on 02/20/2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/612,766 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1-16 are pending in this application.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 6-8 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,881,131 issued to Farris et al. (herein Farris).

With respect to claim 1, Farris discloses entering, by a user, the at least one trademark, tradename, celebrity name, and famous name to be searched in the Web page on the Internet (trademark databases and InterNIC and domain names: see fig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, lines 15); automatically creating a search string including the at least one trademark, tradename, celebrity name, and famous name based on the at least one trademark, tradename, celebrity name, and famous name entered by the user (see fig. 28 and col. 31, lines 10-18 and lines 27-65); providing search results of identified matches corresponding to the search string in the contents of the Web page (col. 20, lines 47-55).

Farris also discloses the Web page on the Internet to be searched; and searching contents of the Web page received for matches in the contents of the Web page address (Internet address or domain name's address: col. 30, lines 57-62 and col. 32, lines 14-20; also see col. 29, lines 53-58).

Farris although teaches the searching of a web page based on Internet or domain name address (col. 30, lines 57-62; also col. 28, lines 32-39 (InterNIC allows a content provider to imbed a country code in a domain name)), the URL address is not explicitly indicated.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the Internet address or domain name's address for display or getting the result of web page or tradename as taught by Farris because it would have made the method being efficiently and effectively to verify and identify the domain name as well as tradename in the InterNic (col. 15, lines 50-67) of the multiple search engines of the Internet network environment.

With respect to claim 2, Farris discloses the document's hyperlinks or link (col. 27, lines 21-30; also see col. 24, lines 7-16 and lines 40-46).

With respect to claim 3, Farris discloses an encrypted connection authenticated by a certificate server (to secure or sealed to send the message: col. 22, lines 24-30)

Claim 6 is essentially the same as claim 1 except that it is directed to a system for searching and reporting an incidence rather than a method (trademark databases and InterNIC and domain names: see fig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, lines 15; see fig. 28 and col. 31, lines 10-18 and lines 27-65; and col. 20, lines 47-55; and Internet address or domain name's address: col. 30, lines 57-62 and col. 32, lines 14-20; also see col. 29, lines 53-58), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 7 is essentially the same as claim 2 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 27, lines 21-30; also see col. 24, lines 7-16 and lines 40-46), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 8 is essentially the same as claim 3 except that it is directed to a system for searching and reporting an incidence rather than a method (to secure or sealed to send the message: col. 22, lines 24-30), and is rejected for the same reason as applied to the claim 3 hereinabove.

With respect to claim 11, Farris discloses a remote computer system connected to the computer system via the Internet for accessing the software program (the remote Web including Web server software: col. 22, lines 52-67, and col. 23, lines 1-17; also see col. 28, lines 16-67).

Claim 12 is essentially the same as claim 1 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (trademark databases and InterNIC and domain names: see fig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, lines 15; see fig. 28 and col. 31, lines 10-18 and lines 27-65; and col. 20, lines 47-55; and Internet address or domain name's address: col. 30, lines 57-62 and col. 32, lines 14-20; also see col. 29, lines 53-58), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 13 is essentially the same as claim 2 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 27, lines 21-30; also see col. 24, lines 7-16 and lines 40-46), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 14 is essentially the same as claim 3 except that it is directed to a software program executing on a computer system for searching and reporting an incidence

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rather than a method (to secure or sealed to send the message: col. 22, lines 24-30), and is rejected for the same reason as applied to the claim 3 hereinabove.

6. Claims 4, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,881,131 issued to Farris et al. (herein Farris) in view of in view of US Patent No. 6,144,962 issued to Weinberg et al. (hereinafter as Weinberg).

With respect to claim 4, Farris discloses a method for searching and reporting as discussed in claim 1.

As to the limitation, "the search results highlight," Farris does not explicitly indicate the trademark, trade name, celebrity name, and famous name found in the web page being highlighted.

However, Weinberg discloses the highlight the text as claimed (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Farris with the teachings of Weinberg so as to have the highlight the text or domain name (Farris - col. 30, lines 47-67). This combination would provide the InterNIC database for the records of registered domain names containing company name, contact, address and IP address (Farris – col. 30, lines 57-62 and col. 31, lines 50-65) and the text being highlighted (Weinberg – col. 3, lines 24-30) are kept on the multiple search engines of the Internet network environment.

Claim 9 is essentially the same as claim 4 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 15 is essentially the same as claim 4 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

7. Claims 5, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,881,131 issued to Farris et al. (herein Farris) in view of in view of US Patent No. 6,422,523 issued to Siegel.

With respect to claim 5, Farris discloses entering, by a user, the at least one trademark, tradename, celebrity name, and famous name to be searched in the Web page on the Internet; automatically creating a search string including the at least one trademark, tradename, celebrity name, and famous name and; receiving a URL address of the Web page on the Internet to be searched; accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string; and providing search results of identified matches corresponding to the search string in the contents of the Web page of the URL address (trademark databases and InterNIC and domain names: see fig. 28 and col. 30,



lines 47-55 and lines 62-67 and col. 31, lines 15; see fig. 28 and col. 31, lines 10-18 and lines 27-65; and col. 20, lines 47-55; and Internet address or domain name's address: col. 30, lines 57-62 and col. 32, lines 14-20; also see col. 29, lines 53-58).

As to the limitation, "creating homonyms and phonetic equivalents of the at least one trademark, tradename, celebrity name, and famous name entered by the user," Farris does not explicitly indicate that the sound or spelling of the at least one trademark, tradename, celebrity name, and famous name entered by the user.

However, Siegel discloses talking database and dictionary database including a plurality of words and distribution of the sounds of them (col. 11, lines 38-67 and col. 12, lines 1-9 and lines 47-50; also see col. 7, lines 58-62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Farris with the teachings of Siegel so as to obtain searching web page based on the domain name or trademark from the InterNic database including the homonyms and phonetic/phonemic of the words (Siegel - col. 12, lines 47-50). This combination would provide the InterNIC database for the records of registered domain names containing company name, contact, address and IP address Farris – col. 30, lines 57-62 and col. 31, lines 50-65) are kept on the multiple search engines of the Internet network environment.

Claim 10 is essentially the same as claim 5 except that it is directed to a system for searching and reporting an incidence rather than a method ('131 of trademark databases and InterNIC and domain names: see fig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, lines 15; see fig. 28 and col. 31, lines 10-18 and lines 27-65;

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col. 11, lines 38-67 and col. 12, lines 1-9 and lines 47-50; also see col. 7, lines 58-62), and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 16 is essentially the same as claim 5 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method ('131 of trademark databases and InterNIC and domain names: see fig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, lines 15; see fig. 28 and col. 31, lines 10-18 and lines 27-65; col. 11, lines 38-67 and col. 12, lines 1-9 and lines 47-50; also see col. 7, lines 58-62), and is rejected for the same reason as applied to the claim 5 hereinabove.

**Contact Information**

8. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to: (703) 746-7238 (after Final Communication and intended for entry)


or: (703) 746-7239 (for formal communications intended for entry)

or: (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL   
Mar. 28<sup>th</sup>, 2003.

  
HOSAINT T. ALAM  
PRIMARY EXAMINER